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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,561	01/18/2002	Winnie C. Durbin	GEMS8081.123	1736

27061 7590 04/14/2006

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/683,561

Applicant(s)

DURBIN ET AL.

Examiner

Michael J. Simitoski

Art Unit

2134

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See explanation below. (See 37 CFR 1.116 and 41.33(a)).

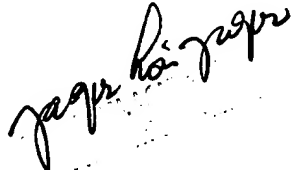
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: A PTO 892 is attached.



Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 U.S.C. §112, ¶2 of claims 1 & 17 (¶14 a, c of the Final Office Action) and one of the outstanding grounds of rejection of claims 10 & 22 under 35 U.S.C. §112, ¶2 (¶14 e of the Final Office Action).

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's response (pp. 7-17) argues that the invention claimed in claim 17 is statutory subject matter. Applicant's response argues that because Applicant's claim 17 creates a functional interrelationship with a computer and recites more than physical characteristics of a form of energy, such as a frequency, voltage or the strength of a magnetic field, define energy or magnetism, per se. As stated in the final Office Action, Applicant has not brought to attention the statutory class under which the invention of claim 17 purportedly falls.

Applicant's response (pp. 10-17) further argues the propriety of claim 17 by citing issued patent claims and further cites issued patent claims with listed Primary Examiners coincident with the instant application. However, it is not within the purview of this Examiner to comment on the validity of previously issued patent claims. All issued patents are assumed valid (35 U.S.C. §282). The fact remains that Applicant's response has failed to supply persuasive arguments as to a specific statutory class under which the invention of claim 17 falls. As the Interim Guidelines, as cited in the previous Office Action, maintain that a signal does not fall within the statutory classes of invention provided under 35 U.S.C. §101, the rejection is maintained.

Applicant's response (pp. 17-18) argues that the rejection of claim 29 under 35 U.S.C. §112 and objection to the specification on the basis that "the specification does not disclose automatically accepting a verification email from the user verifying self-activation of the disabled option" should be withdrawn. Applicant cites from the specification at least "In another embodiment, the user can provide a verification email forwarded to the company at 420 verifying self-activation of the software option." However, as described at length in the previous Office Action, the phrase "automatically accepting" is not defined so as to differentiate the limitation from simply "accepting".

Applicant's response (p. 19) argues that the user is remote. In light of Applicant's arguments, the claim is understood such that the user is remote and the rejections relating to this limitation are withdrawn.

Applicant's response (pp. 19-23) argues the amendatory language of claims 10 and 22. However, these amendments are not entered because removal of the word "of" changes the scope of the claim to include a data entry module not connected to the medical imaging device and therefore requires further search.

Applicant's response (p. 23), regarding 14 of the Office Action, argues that the user is clear. In light of these arguments, this rejection is withdrawn. It is understood that any user which interacts with the imaging device or interacts with the activation of options on the device is considered a user.

Applicant's response (pp. 24-32) argues each reference separately as not teaching a feature of the combined invention. However, as stated in the Office Action, each reference is not relied upon individually, but rather the combination of the references. It is maintained that the references, in the cited combination(s), teach a sequence of instructions which, when executed by the at least one processor, causes the at least one processor to received, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device.

Applicant's response (p. 32) argues "the Office Action does not allege that the art of record provides any teaching, suggestion or incentive for modifying the citations of Steinmetz, Whigham, Fenstermaker, Rive, Mccown, Castagna, Dutta, Rose and/or Takae to provide the claimed approach. However, the Office Action cites, from each reference, motivation for the proposed combinations. Therefore, this argument is not persuasive.

Applicant's response (p. 33) traverses the Examiner's Official Notice that renting an item for thirty days is old and well established in the art of renting/leasing, as impermissible hindsight. In support of the Official Notice, the Examiner cites U.S. Patents 5,790,664 to Coley et al. (col. 2, lines 27-40), 5,845,065 to Conte et al. (col. 24, lines 42-65) and 6,243,692 to Floyd et al. (col. 2, lines 8-17) for teaching enabling disabled software for a period of thirty days, where software is enabled by purchasing the temporary enablement. Further, U.S. Patent Application Publications 2002/0029347 to Edelman (34-35, 89, 94, 98 & 132-133), 2001/0034712 to Colvin (50), 2002/0108054 to Moore et al. (29) and 2002/0128842 to Hoi et al. (54, 56, 60 & 67-68) are cited for teaching enabling software for a period of thirty days.

